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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,504	10/05/2005	Roy Hom	02-1033-A6	6751
20306 7590 06/12/2009 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER SOLOLA, TAOFTQ A				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
06/12/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/529,504

**Applicant(s)**

HOM ET AL.

**Examiner**

Taofiq A. Solola

**Art Unit**

1625

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1.5-7.9, 10 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) 13-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1.5-7.9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Claims 1, 5-7, 9-10, 13-15 are pending in this application.

Claims 13-15 are drawn to non-elected inventions.

Claims 2-4, 8, 11-12 are deleted.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 5-7, 9-10, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As written, the claims are confusing, not clear and therefore are indefinite. It is impossible to ascertain the metes and bounds of the claims. There are extensive substitutions and substitutions within substitutions so as made it impossible to ascertain the compounds excluded and/or included by the claims. The claims must be written in such way as to be clear and distinctly point out the claimed subject matter. In patent examination, it is essential for claims to be precise, clear, correct, and unambiguous. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989).

It is not possible to classify and/or search the entire scope of the claims for practical reasons and technical limitations. While the limited examples in the specification are classifiable the entire scope of the claims cannot be classified as required under 35 USC 8 because the entire structures cannot be ascertained. See MPEP 903. Under 35 USC 8, MPEP 903, the scope of all claims must be classified. The class and subclass(es) must be searched to determine patentability. It is

mandatory under the US patent practice that every allowed claim be classified. MPEP 904. While the statute may not require applicant to draft a claim in terms pertinent to the USPTO classification system, applicant should note that the Examiner needs not allow such a claim because the Office must perform its duty in conformance with 35 USC 8 and other relevant statutes.

By amending the claims as suggested under Status of Claims, subra, the rejection would be overcome.

### ***Response to Argument***

Applicant's arguments filed 4/30/09 have been fully considered but they are not persuasive. Applicant amended the claims but not within the scope of searchable inventions as set forth under Status of Claims. Applicant now contends the claims meet the requirements of 35 USC 112. This is not persuasive for reasons set forth above, and because applicant fails to provide conclusive evidence in support of the contention. Applicant has failed to adequately inform the public what applicant regards as his/her invention, so as to avoid infringement of any patent(s) arising from the application. Applicant should be on notice that such patent(s) will be subject to invalidation by the US courts.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-7, 9-10, are rejected under 35 U.S.C. 103(a) as being unpatentable over Maillard et al., WO 02/02512 A2.

Applicant claims compounds of formula I, and their composition. The compounds are useful for treating Alzheimer's diseases.

Determination of the scope and content of the prior art (MPEP 2141.01)

The prior arts teach similar compounds, their compositions and method of use for treating Alzheimer's diseases. See the abstract and the examples on pp. 118-643.

Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)

The difference between the instant invention and that of the prior art is that applicant claims alkyl instead of H by the prior art. Also the amine bearing R1 is a 3° instead of 2° amine by the prior art.

Finding of prima facie obviousness--rational and motivation (MPEP 2142.2413)

However, H and alkyl are art recognized equivalents. *In re Lincoln*, 126 USPQ 477, 53 USPQ 40 (CCPA, 1942); *In re Druey*, 319 F.2d 237, 138 USPQ 39 (CCPA, 1963); *In re Lohr*, 317 F.2d 388, 137 USPQ 548 (CCPA, 1963); *In re Hoehsema*, 399 F.2d 269, 158 USPQ 598 (CCPA, 1968); *In re Wood*, 582 F.2d 638, 199 USPQ 137 (CCPA, 1978); *In re Hoke*, 560 F.2d 436, 195 USPQ 148 (CCPA, 1977); *Ex parte Fauque*, 121 USPQ 425 (POBA, 1954); *Ex parte Henkel*, 130 USPQ 474, (POBA, 1960).

Also, 2° and 3° amines are obvious variants. *Ex parte Bluestone*, 135 USPQ 199 (1961). Therefore, the instant invention is prima facie obvious from the teaching of the prior arts. One of ordinary skill in the art would have known to claim the compounds

and their compositions at the time the invention was made. The motivation is from knowing that H and alkyl are equivalents and that 2° and 3° amines are obvious variants.

### ***Response to Argument***

Applicant's arguments filed 4/30/09 have been fully considered but they are not persuasive. Applicant contends the instant compounds and that of the prior art are not expected to have the same activity. This is not persuasive for reasons set forth above, and because applicant fails to provide data from assays in support of the contention. Applicant must show unexpected result through a side-by-side comparison.

### ***Status of Claims***

Having found the elected species in condition for allowance and not been able to search the entire scope of the claims, additional species are searched "to the extent necessary to determine patentability." See MPEP 803.02. The search is extended to include compounds wherein R2-R3, R20, RN are as defined in claim 1; R1 is C1-C6-alkylphenyl and RC is limited to isothiochromene which is attached as in the elected species. The phenyl and isothiochromene are optionally substituted.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

/Taofiq A. Solola/

Primary Examiner, Art Unit 1625

June 9, 2009